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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,669	05/13/2002	H. Darrel Darby	A7705	6168
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SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. WASHINGTON, DC 20037				
			EXAMINER PATTERSON, MARIE D	
			ART UNIT 3728	PAPER NUMBER 9

DATE MAILED: 12/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/019,669

Applicant(s)

DARBY, H. DARREL

Examiner

Marie Patterson

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 33,34,37,39 and 40 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 25-30 is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,7,8,10,11,31,32,35,36 and 38 is/are rejected.
- 7) ☒ Claim(s) 3,6,9 and 12-24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2&6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Restriction/Election

1. Claims 26-30 have been rejoined and examined due to the allowability of claim 25 from which these claims depend.

Claims 33 and 34 remain withdrawn as directed towards a nonelected invention. It is noted that these claims depend from claim 32 which is not patentable/allowable and therefore there is no inventive concept present.

Claims 37, 39, and 40 remain withdrawn as directed towards a nonelected invention. It is noted that these claims depend from claim 35 or claim 36 which is not patentable/allowable and therefore there is no inventive concept present.

Claim Rejections - 35 USC § 112

2. Claims 31 and 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 31 it is not clear if applicant is claiming certain elements such as “the upper assembly” and “the out sole”. The preamble of the claim recites “An insole assembly”, however it appears that applicant is claiming other elements that are not normally considered part of an insole assembly. Clarification is requested.

In claim 31 the phrase “insole assembly adaptable for treating a weight bearing...” is functional, indefinite, and incomplete because it is not clear what structural limitations applicant intends to encompass with such language. There has been no recitation of any structure which would perform the recited function.

In claim 32 the phrase "the edge of the oval area" lacks antecedent basis rendering the claim vague and indefinite.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 31 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Boisvert (4813157).

Boisvert shows an insole comprising a plurality of layers which are removable and the insole assembly is adaptable for treating a weight bearing area by removing an oval area (see area 30 and specification column 3 lines 45-60) as claimed.

5. Claims 35, 36, and 38 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Darby (5370133).

Darby shows a shoe comprising an outsole (16) with a circumferential counter (shown at 16A) and a fitting marker (front of element 32) and the outsole has a tapered toe (22C) and Heel (22B), and flat middle portion (22A) as claimed.

In reference to claim 38, Darby '133 shows an insole comprising an insole having a plurality of distinct layers (shown in figure 1) as claimed.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 2, 4, 5, 7, 8, 10, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Darby (5491909) in view of Darby (5370133) and Grim (5329705).

Darby '909 shows a shoe comprising an outsole (16), an upper (14), an insole assembly (18), and a shank (22) substantially as claimed except for the sole having a circumferential counter portion and the exact layered insole. Darby '133 teaches providing an outsole with a circumferential counter portion (shown as 16A in figure 1). Grim teaches providing an insole with a plurality of different layers for use in a medical shoe. It would have been obvious to provide the outsole with a counter portion as taught by Darby '133 and to provide an insole having a plurality of layers as taught by Grim in the shoe of Darby '909 to provide greater stability to the outsole/upper construction and to increase the cushioning and medical benefits of the insole construction taught by Grim.

8. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Boisvert in view of Kellerman (5799414).

Boisvert shows an insole assembly substantially as claimed except for skiving the edges of the oval area. Kellerman teaches skiving/chamfering the edges of an opening (see column 5 lines 27-46). It would have been obvious to skive/chamfer the edges of the opening as taught by

Kellerman in the insole assembly of Boisvert to provide a smooth transition and to make the removable portion easier to remove.

Allowable Subject Matter

9. Claims 25-30 are allowed.
10. Claims 3, 6, 9, and 12-24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
11. Telephone inquiries regarding the status of application or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the Examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148 or the **Tech Center 3700 Customer Service Center number is (703) 306-5648**. For applicant's convenience, the Group Technological Center FAX number is (703) 872-9306. (Note that the Examiner **cannot** confirm receipt of faxes) Please identify Examiner ____ of Art Unit ____ at the top of your cover sheet of any correspondence submitted.

Inquiries only concerning the **merits** of the examination should be directed to Marie Patterson whose telephone number is (703) 308-0069.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g. copies of references cited, form PTO-1449, for PTO-892, etc. requests for copies of such papers should be directed to (703) 308-1337.

Check out our web-site at "www.uspto.gov" for fees and other useful information.



Marie Patterson
Primary Examiner
Art Unit 3728